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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,486	11/27/2001	Shinichi Watanabe	P20705	8162
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GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			KOROBV, VITALI A	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,486

Applicant(s)

WATANABE ET AL.

Examiner

Vitali Korobov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the amendment filed on 04/21/2005.

Claims 1 – 11 were cancelled. Claims 12 – 17 were added and are pending in this Office Action.

Specification

2. The amendment filed to the Specifications is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Paragraph [0006.1] of the amendment to the Specification recites a controller included in the server (See line 7 of paragraph [0006.1] and line 9 of paragraph [0006.2]). Paragraph [0006.2] of the amendment to the Specification recites a controller included into the transmitting IP apparatus (See line 4 of [0006.2]).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 12-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 12 contains a limitation of a "controller, configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus". Said controller was not described in the specification or the drawings in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The dependent claims 13 – 15 are rejected as having the same deficiencies as the claim 12 they depend from.

Claim 16 contains a limitation of a "controller configured to set, in an e-mail, the input telephone number of the receiving IP apparatus" and a "controller configured to receive the e-mail from the transmitting IP apparatus". Said controllers were not described in the specification or the drawings in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 17 is rejected in view of the above rejection of claim 12. Claim 17 is essentially the same as claim 12, except that it sets forth the invention as a method

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rather than a server apparatus, as does claim 12. Therefore, claim 17 is rejected under the same rationale as the above rejected claim 12.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 14 recites the limitation "the H.323 gate keeper" in line 5 of said claim 14. There is insufficient antecedent basis for this limitation in the claim.

In preparing this Office action the Examiner assumed "the H.323 gate keeper" to mean "the H.323 gatekeeper" and made the appropriate modification in the language of the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 12, 13 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,987,508, dated Nov. 16, 1999 and issued to Agraharam et. al (hereinafter Agraharam).

Regarding claim 12, Agraharam teaches a server apparatus connected to a transmitting IP apparatus, the transmitting IP apparatus transmitting an e-mail to a

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receiving IP apparatus via the server apparatus, the server apparatus comprising: a memory configured to store an IP address of the receiving IP apparatus associated with a telephone number of the receiving IP apparatus (Fig. 1, translation server 110, database 117. See also col. 3, lines 40-46, that teach that an actual recipient's e-mail address is stored in association with the recipient's telephone number. Databases are known in the art to inherently contain memory for storing data); a receiver configured to receive the e-mail from the transmitting IP apparatus, the e-mail including the telephone number of the receiving IP apparatus (Col. 3, lines 53-55. Server 110 receives an e-mail from a client terminal 101, including a telephone number of recipient); and a controller configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus (Col. 3, lines 56-59. The server obtains the telephone number address identity to access the database 117), to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus (Col. 3, lines 59-62), and to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus (Col. 3, lines 62-66. See also Fig. 1 – receiving IP apparatus 102).

Regarding claim 13, Agraharam teaches the server apparatus according to claim 12, wherein the controller transmits an error message to the transmitting IP apparatus when the memory does not store the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus (Col. 4, 26-34).

Regarding claim 15, Agraharam teaches the server apparatus according to claim 12, wherein a header of the e-mail from the transmitting IP apparatus includes the telephone number of the receiving IP apparatus (Col. 3, lines 39-47).

Regarding claim 16, Agraharam teaches a communication system comprising: a transmitting IP apparatus (Fig. 1, item 101); and a server apparatus (Fig. 1, item 110), the transmitting IP apparatus comprising: a panel configured to input a telephone number of a receiving IP apparatus (Fig. 1, item 101 – computer keyboard); and a controller configured to set, in an e-mail, the input telephone number of the receiving IP apparatus (Fig. 1, item 101 – computer CPU, running a Sendmail Daemon (col. 3, lines 56-59), and to transmit, to the server apparatus, the e-mail including the input telephone number of the receiving IP apparatus (Col. 3, lines 62-63), the server apparatus comprising: a memory configured to store an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus (Fig. 1, database 117); and a controller configured to receive the e-mail from the transmitting IP apparatus (Col. 3, lines 56-59), to obtain, from the received e-mail, the telephone number of the receiving IP apparatus (Col. 3, lines 56-59), to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus (Col. 3, lines 59-62), and to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus (Col. 3, lines 62-63).

Claim 17 is rejected in view of the above rejection of claim 12. Claim 17 is essentially the same as claim 12, except that it sets forth the invention as a method

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rather than a server apparatus, as does claim 12. Therefore, claim 17 is rejected under the same rationale as the above rejected claim 12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam, as applied to claim 12 above, and further in view of the U.S. Patent 6,735,617 to Goodman (hereinafter Goodman).

Regarding claim 14, Agraharam teaches the server apparatus according to claim 12, but fails to explicitly teach additional limitations of claim 14 regarding said server apparatus being connected to an H.323 gateway wherein translation or look-up tables

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are stored. In addition, Agraharam teaches that a translation database (Fig. 1, item 117) does not have to be co-located with the server 110, and could be located elsewhere on Internet. Agraharam further teaches alternative means, such as the use of LDAP, for retrieval from the database of the necessary associated e-mail address based on the recipient's telephone number. Goodman teaches a system for routing of an e-mail over an H.323 gateway (spelled as H 323 in Goodman) and a server apparatus further being connected to a H.323 gatekeeper, the H.323 gatekeeper storing the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus (See Fig. 10, sender's mail server 950, and the outbound H.323 gateway 965. See also col. 4, lines 6-7, where Goodman teaches an H.323 gatekeeper's function of finding an IP address for a gateway associated with a telephone number) wherein, when the memory does not store the IP address of the receiving IP apparatus, the controller accesses the H.323 gate keeper to obtain the IP address of the receiving IP apparatus (See Col. 4, lines 65-67, where Goodman teaches that the "IP address – telephone number" look-up table may be maintained at the facsimile mail server or at the H.323 Gatekeeper).

Agraharam and Goodman are analogous art because they are both related to seamless cross-service connectivity in telecommunications network. Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the alternative locations for a look-up table taught by Goodman with the teachings of alternative locations for translation database 117 of Agraharam in order to take advantage of special records designating which IP addresses are mail servers

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and make cross-service connectivity in telecommunications network even more seamless and efficient (See col. 3, lines 62-67 and col. 4, lines 1-8 of Goodman).

Response to Arguments

7. Applicant's arguments filed on 04/21/2005 have been fully considered but they are not persuasive.

With respect to claims 12-17, the Applicants argue – *“The newly submitted claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.”*

The Examiner respectfully disagrees. The introduction of a “controller” in claims 12 and 16 is introduction of new matter that changes the scope of said claims 12 and 16 and their dependent claims. Applicant's arguments with respect to claims 12-13 and 15-17 have been considered but are moot in view of the new ground(s) of rejection.

With respect to claim 14 and applicability of Goodman, the Applicants argue – *“However, in GOODMAN, the facsimile message is delivered to the recipient's facsimile machine 975 over a “conventional telephone network” 970. Thus, the recipient's facsimile machine 975 does not have an IP address. In other words, GOODMAN does not disclose a memory which stores an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus”.*

The Examiner respectfully disagrees. Claim 14 contains no mention of the “recipient's facsimile machine”. It is directed to an “IP apparatus” and a “server apparatus”. The outbound gateway 965, connected to IP Network 940 clearly fits both of

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these descriptions. Further, the ability of various devices, including Internet-enabled fax machines, to connect to the Internet over "conventional telephone network" is well known in the art and therefore the recipient's facsimile machine, even if claim 14 was directed to it, is not precluded from having an IP address.

The Applicants further argue – *"Thus, GOODMAN cannot obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number and can not transmit the received e-mail to the receiving IP apparatus, based on the obtained IP address of the receiving IP apparatus. Thus, GOODMAN additionally cannot disclose a server apparatus which stores an IP address of the receiving IP apparatus associated with a telephone number of the receiving IP apparatus."*

GOODMAN also does not disclose a server apparatus which obtains, from the received e-mail, the telephone number of the receiving IP apparatus, obtains, from a memory, the IP address of the receiving IP apparatus associated with the telephone number, and transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus. Additionally, Fig. 13 of GOODMAN shows a gatekeeper lookup table which contains zones, gateway addresses, and gateway priority. However, none of these teach an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, since the facsimile message is delivered to the recipient's facsimile machine 975 over a conventional telephone network 770. Thus, GOODMAN does not comply with requirements, recited in the pending claims, so the pending claims are clearly distinguished over GOODMAN."

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Therefore, it is respectfully submitted that the features recited in Applicants' submitted claims 12-17 are not disclosed in GOODMAN cited by the Examiner.

The Examiner respectfully points out that Goodman was not applied as a reference for limitations of claims 12-17 and the features recited above by the Applicants. It has been used in combination with Agraharam to reject claim 14 and the specific features related to an H.323 gateway and the associated H.323 gatekeeper. Therefore, the Applicant's arguments are moot. A detailed mapping of the limitations of claim 14 to the relevant parts of Goodman can be found in the above rejection of said claim 14.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vitali Korobov
Examiner
Art Unit 2155

VAK
07/03/2005



SALEH NAJJAR
PRIMARY EXAMINER